

UNITED STATES PATENT AND TRADEMARK OFFICE

OFFICIAL

Examiner: Srilakshmi K. Kumar

Art Unit: 2675

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In re:

Applicant: Jan Peter JANSSEN

Serial No.: 09/936,548

Filed: January 17, 2002

A M E N D M E N T

August 5, 2004

Commissioner for Patents
P. O. Box 1450
Alexandria, Virginia

Sir:

This communication is responsive to the Office Action of April
5, 2004.

In the Office Action the Examiner rejected the claims under 35 U.S.C. 103(a) as being unpatentable over the patent to Scott '562 in view of the patent to Scott '090.

In the Examiner's opinion the present invention can be derived from the references in combination with one another.

After carefully considering the Examiner's grounds for the rejection of the claims, applicant has retained the claims as they were.

It is respectfully submitted that the new features of the present invention as defined in the claims clearly and patentably distinguish the present invention from the prior art.

Claim 1, the broadest claim on file, defines a device for information input and/or output, which is different from the device disclosed in the patents to Scott. The patent to Scott '562 does not disclose a touch-sensitive layer, because a fingerprint scanner identified in Figure 1 of this patent with reference numeral '108 is not touch-sensitive. The patent to Scott '562 remains silent about the technology of the mentioned fingerprint scanner.

The patent to Scott '090 discloses that the image of the fingerprint is captured by a SSD camera. A SSD camera is not touch-sensitive and therefore the fingerprint scanner is also not touch-sensitive.

It is therefore believed to be clear that none of the patents to Scott teaches or suggests a display with a touch-sensitive layer.

The patent to Scott '090 does not disclose that the device fits into a frame that is suitable for a surface-mounted socket, because this reference neither discloses that the device fits into a frame, nor the frame is suitable for a surface-mounted socket. In addition to the above, the patents to Scott do not teach to combine these features and to use a frame which is suitable for both a recessed and a surface-mounted socket.

It is therefore believed that the new features of the present invention which is defined in claim 1 is not disclosed in the references and can not be derived from them as a matter of obviousness.

Claim 1 should be considered as patentably distinguishing over the art and should be allowed.

As explained hereinabove, the new features of the present invention are not disclosed in the references, and the references did not contain any hint or suggestion that such features can be provided in them. In order to arrive at the applicant's invention from the references, the references have to be fundamentally modified. However, it is known that in order to arrive at a claimed invention, by modifying the references the cited art must itself contain a suggestion for such a modification.

This principle has also been consistently upheld by the U.S. Court of Customs and Patent Appeals which, for example, held in its decision in re Randol and Redford (165 USPQ 586) that

Prior patents are references only for what they clearly disclose or suggestion; it is not a proper use of a patent as a reference to modify its structure to one which prior art references do not suggest.

Definitely, the references would not lead a person of ordinary skill in the art to such significant modifications, by including in them the features which were first proposed by the applicant.

The Examiner's attention is now respectfully directed to the features of claim 8 and 9. The paragraph of the patent to Scott '562 cited by the Examiner, namely column 6, lines 13-30, 63-column 7, line 5, neither

teach nor support that the operator control elements and the information fields shown by the display are programmable, nor that the processor rearranges the operator control elements and the information fields shown by the display at predetermined time intervals on the principle of randomness.

It is therefore believed that the new features of claims 8 and 9 are not disclosed in the references and can not be derived from them as a matter of obviousness, and therefore claims 8 and 9 should be considered as patentably distinguishing over the art not only because of their dependency on the independent presumably allowable claim, but also because they contain the patentable subject matter per se.

The features of claim 10 are also not disclosed in the prior art. The paragraph in column 8, lines 32-67 of the patent to Scott '562 neither teaches nor suggests that the processor allows a configuration not that the processor offers configuration menus. Claim 10 should also be considered as patentably distinguishing over the art per se.

As for the other claims, these claims depend on claim 1, they share its presumably allowable features, and therefore it is believed that they should be allowable as well.

It has been noticed that the Examiner has not considered an IDS filed simultaneously with the application on September 14, 2001. Consideration of the IDS is respectfully requested.

Reconsideration and allowance of the present application is most respectfully requested.

Should the Examiner require or consider it advisable that the specification, claims and/or drawings be further amended or corrected in formal respects in order to place this case in condition for final allowance, then it is respectfully requested that such amendments or corrections be carried out by Examiner's Amendment, and the case be passed to issue. Alternatively, should the Examiner feel that a personal discussion might be helpful in advancing this case to allowance, he is invited to telephone the undersigned (at 631-549-4700).

Respectfully submitted,

A handwritten signature in black ink, consisting of several stylized, overlapping strokes that form a cursive-like shape.

Michael J. Striker
Attorney for Applicants
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